

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/680,479

REMARKS

Claims 1 and 3-32 are pending. Upon entry of the present Amendment, claims 1, 3-24, 27-29 and 32 are amended. No new matter is presented

To summarize the Office Action, the Examiner rejected claims 1 and 10 under 35 U.S.C. § 103(a) based on Dozier et al. (U.S. Patent No. 5,870,552, hereinafter “Dozier”) in view of Katz et al. (U.S. Patent No. 6,496,872, hereinafter “Katz”), further in view of Haruyama (U.S. Patent No. 5,902,948). Also, the Examiner rejected claims 3-9 and 11-32 under 35 U.S.C. § 103(a) based on Dozier et al., Katz et al., and Haruyama, further in view of Pepe et al. (U.S. Patent No. 5,742,905, hereinafter “Pepe”). In addition, the Examiner rejected claims 20-21 under 35 U.S.C. § 101, as allegedly being nonstatutory subject matter. Each ground of rejection is addressed as follows.

Claim Rejections - 35 U.S.C. § 101

Claims 20-21 stand rejected as allegedly being directed to non-statutory subject matter. Applicant submits that this ground of rejection is moot in view of the amendment to claims 20-21, which have been amended to recite “a computer-readable storage medium for controlling a portable terminal...” Accordingly, withdrawal of the rejection of these claims is requested.

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Claim Rejections - 35 USC § 103

A. *Rejection of claims 1 and 10*

Claims 1 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dozier in view of Katz, and further in view of Haruyama. Applicant traverses this ground of rejection.

Independent claim 1 recites a novel portable terminal system that is neither anticipated nor suggested by the cited art. For instance, claim 1 defines a server which stores text content and help content, wherein the help content includes specific information regarding how to retrieve or use the text content. Further, claim 1 defines a portable terminal which comprises a text browser which accesses and processes the text content stored in the server, and a help browser which processes the help content stored in the server. Also, as recited by claim 1, at least one hardware function of the portable terminal is automatically controlled based on the processed help content in order to assist a user in utilizing the text content.

In rejecting claim 1, the Examiner contends that Dozier teaches a server that stores text content and help content. For instance, the Examiner analogizes the source document to the claimed text content, and asserts that “suggested anchor link item links to target documents from the lists of suggested and potential targets” of Dozier teaches the claimed help content. (Office Action at page 3 (emphasis original)).

Dozier teaches a development platform for publishing multimedia documents across wide area networks. (Dozier at col. 3, lines 41-49). According to Dozier, the creation of hypermedia

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links in the creation of multimedia documents may be facility and partially automated by the use of “NaviLinks”, which uses statistical language processing algorithms to generate a list of suggested, possible hypermedia links between a source document and a collection of potential target documents. (Dozier at col. 13, lines 57-65). Further, Dozier teaches that a human author can review the suggestions and choose to incorporate, modify, or discard them. (Dozier at col. 13, lines 65-67). Thus, the development platform of Dozier merely provides a means of automating the task of links from within documents, such as news articles, product brochures, and other literature, which were originally created for non-interactive environments and, thus, do not initially contain any hypermedia links to other documents. (see Dozier at col. 13, lines 52-57).

In the rejection of claim 1, the Examiner contends that suggested anchor items corresponds to the claims “help content”. However, the suggested anchor items in Dozier are simply suggested hyperlinks to target documents which may be selected by the user to incorporate into a hypermedia document. (Dozier at col. 14, lines 30-33). Thus, there is no teaching or suggestion that these suggested hyperlinks include any information regarding how to retrieve or use the text content, because the hyperlinks are merely links from a source document to other related documents. Stated differently, the links are provided to direct users to content *other than the source document*. There is absolutely no teaching or suggestion that the links include any information regarding the retrieval or use of the source document itself. Therefore, Applicant submits that Dozier fails to teach the help content, as defined by claim 1.

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Moreover, Applicant submits that the combination of the teaching of Katz to the hypermedia authoring system taught by Dozier is improper and fails to compensate for the deficient teaching of Dozier. For instance, Katz teaches a computer application program which enables the computer to automate certain tasks, wherein the tasks are performed in response to a triggering event. (Katz at col. 3, lines 21-25). In the rejection of claim 1, the Examiner contends that the motivation to combine Katz with Dozier is “to enable the user to speed up the process by concentrating on the accomplishment of goals, rather than focus on how to use a computer.” (Office Action at page 4). However, this alleged motivation is stated in Katz in reference to a “Do It For Me” function, which, according to Katz, allows the user to enter information regarding a particular task, such as parameters for the task of backing up files, and the computer then carries out the task without input for the user. (Katz at col. 5, lines 13-25). Thus, the user may specify what files are to be backed up and the destination for copying the back-up files, and, as a result, the application program will perform the task without further input from the user. (Katz at col. 5, lines 25-26).

However, Katz fails to provide any teaching or suggestion whatsoever regarding the automation of authoring of web pages, nor does Katz mention anything remotely related to suggested links for authoring web pages. Therefore, even assuming that Dozier could be interpreted to teach “help content”, there would still be no logical reason to modify Dozier with the teachings of Katz. For instance, Dozier teaches that a list suggested links to other content is provided to the user, which the user must necessarily select from the content which he or she

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desires to be included. (*see* Dozier at lines 13, col. 65-67). Clearly, Katz fails to teach or suggest any automation to the selection of content to be included in hypermedia documents. Rather, the teaching of Katz is limited to automation of routine computer tasks such as adjusting the screen resolution, backing up files, checking for new files, and running a virus checker. (*see, e.g.*, Katz at Fig. 8 and col. 8, lines 47-67). Moreover, the “automated tasks” which are taught by Katz are necessarily performed in response to triggering events, such as a time the task is to be performed. The Examiner has completely failed to provide any line of reasoning as to how the selection of desired web pages from a list of suggested links could be performed in response to such a triggering event.

Further, even assuming for the sake of argument that the combination of Katz and Dozier could somehow be construed as properly formed, the combination of Haruyama would nonetheless be improper. In the rejection of claim 1, the Examiner concedes that the combination of Katz and Dozier fails to teach that help content automatically controls hardware functions. To compensate for this deficiency, the Examiner relies on Haruyama, which allegedly would “ease the system user to improve visualization and time efficiency during navigating/learning process with the computer system.” (Office Action at page 4).

However, Applicant submits that the teaching of Haruyama is completely unrelated to either Dozier or Katz, whether taken individually or in combination. For instance, Haruyama teaches a music performance instructing apparatus for a keyboard. As taught by Haruyama, the musical keyboard includes lights which instruct a user as to which notes should be played at

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particular times. Thus, Haruyama provides for an automated performance guide which is capable of multiple performance levels, where a user may select a performance level corresponding to his or her capability. (*see* Haruyama at col. 3, lines 9-26). Further, Haruyama teaches that four performance levels may be provided, wherein the guide tracks (i.e., notes of a song) are used to illuminate LEDs on the keys to indicate the particular note which should be played at a given time. The different performance levels specify how much of the guide track for a particular song will be presented to the user in the form of the sequence of lighted LEDs. (Haruyama at col. 15, line 66 - col. 16, line 15).

The musical instruction taught by Haruyama is completely unrelated to either the authoring of web pages taught by Dozier or the automation of computer tasks, such as backing up files, taught by Katz. That is, Haruyama's automated performance guide for music bears no relationship to either of the teachings of Katz or Dozier, nor does Haruyama provide any teaching or suggestion for modifying any combination of Dozier and Katz, assuming such combination could somehow be construed as proper. Moreover, even assuming that the performance guide data could be interpreted as "help content", there is no relation of the help content to any text content, nor does the help content include any information regarding use or retrieval of text content, as recited by the claim. Thus, there can not be any rational basis for combining these clearly unrelated teachings. Applicant submits that the Examiner has failed to provide any convincing line of reasoning to support the combination in the manner suggested. Further, the combination of Dozier, Katz and Haruyama can not be properly interpreted to teach

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all the claim limitations, and the combination is based on impermissible hindsight reasoning which has been supplied by the Examiner to improperly support this inadequate combination.

As evidenced by the foregoing, Applicant submits that the Examiner has failed to demonstrate *prima facie* obviousness with respect to the combination of Dozier in view of Katz, further in view of Haruyama, and reconsideration and withdrawal of the rejection of claim 1 is requested. Further, Applicant submits that the above arguments are equally applicable to independent claim 10, which similarly recites a portable terminal. Therefore, reconsideration and withdrawal of the rejection of claim 10 is requested.

B. Rejection of claims 3-9 and 11-32

Claims 3-9 and 11-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dozier in view of Katz, further in view of Haruyama, and further in view Pepe. Applicant submits that these claims are allowable *at least* for the reasons discussed above regarding the improper combination of Dozier, Katz and Haruyama. Accordingly, reconsideration and withdrawal of the rejection of claims 3-9 and 11-32 is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



Brian K. Shelton
Registration No. 50,245

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
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